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| APPLICATION NO.             | FILING DATE                           | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|-----------------------------|---------------------------------------|----------------------|-------------------------|------------------|
| 09/675,938                  | 09/29/2000                            | James E. McShane     | FC0807Q1                | 1065             |
| 24265 7.                    | 590 01/29/2002                        |                      |                         | <u> </u>         |
| SCHERING-PLOUGH CORPORATION |                                       |                      | EXAMINER                |                  |
| 2000 GALLOP                 | ARTMENT (K-6-1, 199<br>PING HILL ROAD | 90)                  | SHARAREH, SHAHNAM J     |                  |
| KENILWORTH, NJ 07033-0530   |                                       |                      | ART UNIT                | PAPER NUMBER     |
|                             |                                       |                      | 1617                    |                  |
|                             |                                       |                      | DATE MAILED: 01/29/2002 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|   | Applic                  | cation No.                            | Applicant(s)  |  |  |  |
|---|-------------------------|---------------------------------------|---|--|--|--|
|   |                         | 5,938                                 | MCSHANE, JAMES E.                                       |  |  |  |
| Offic Action Summary  |                         |                                       | Art Unit  |  |  |  |
| · · · · · · · · · · · · · · · · · · ·   |                         | am Sharareh                           | 1617  |  |  |  |
| The MAILING DATE of this comm   |                         |                                       |   |  |  |  |
| Period for Reply  |                         |                                       |   |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).  Status |                         |                                       |   |  |  |  |
| 1)⊠ Responsive to communication(s)  | ) filed on 29 Septeml   | ber 20 <u>00</u> .                    |   |  |  |  |
| 2a) ☐ This action is FINAL.   | 2b) ☐ This action       | · · · · · · · · · · · · · · · · · · · |   |  |  |  |
| 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  |                         |                                       |   |  |  |  |
| Disp sition of Claims   |                         |                                       |   |  |  |  |
| 4) Claim(s) 1-20 is/are pending in the application.   |                         |                                       |   |  |  |  |
| 4a) Of the above claim(s) is/are withdrawn from consideration.  |                         |                                       |   |  |  |  |
| 5) Claim(s) is/are allowed.   |                         |                                       |   |  |  |  |
| 6) Claim(s) is/are rejected.  |                         |                                       | •   |  |  |  |
| 7) Claim(s) is/are objected to  |                         |                                       |   |  |  |  |
| 8) Claim(s) 1-20 are subject to restriction and/or election requirement.  |                         |                                       |   |  |  |  |
| Application Papers  |                         |                                       |   |  |  |  |
| 9) The specification is objected to by the Examiner.  |                         |                                       |   |  |  |  |
| 10) The drawing(s) filed on is/a  | re: a)□ accepted or b   | )  objected to by the Exa             | miner.  |  |  |  |
| Applicant may not request that any  | objection to the drawin | g(s) be held in abeyance. S           | See 37 CFR 1.85(a).                                     |  |  |  |
| 11)☐ The proposed drawing correction f  | iled on is: a)[         | ☐ approved b)☐ disappro               | oved by the Examiner.                                   |  |  |  |
| If approved, corrected drawings are required in reply to this Office action.  |                         |                                       |   |  |  |  |
| 12) The oath or declaration is objected to by the Examiner.   |                         |                                       |   |  |  |  |
| Pri rity under 35 U.S.C. §§ 119 and 120   |                         |                                       |   |  |  |  |
| 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).   |                         |                                       |   |  |  |  |
| a) All b) Some * c) None of:  |                         |                                       |   |  |  |  |
| 1. Certified copies of the priority documents have been received.   |                         |                                       |   |  |  |  |
| 2. Certified copies of the priority documents have been received in Application No  |                         |                                       |   |  |  |  |
| <ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>   |                         |                                       |   |  |  |  |
| 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  |                         |                                       |   |  |  |  |
| a) ☐ The translation of the foreign language provisional application has been received.  15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.  |                         |                                       |   |  |  |  |
| Attachment(s)   |                         |                                       |   |  |  |  |
| 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review 3) Information Disclosure Statement(s) (PTO-1449)   |                         |                                       | y (PTO-413) Paper No(s)<br>Patent Application (PTO-152) |  |  |  |

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## Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-10, drawn to pressurized aerosol composition, classified in class
   424, subclass 47.
- II. Claims 11-16, drawn to a concentrate composition, classified in class 424, subclass 67 or 400.
- III. Claims 17-20, drawn to methods of treating foot or shoe odors, classified in class 424, subclass 642.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I or II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process as claimed can be practiced with various materially different products such as other known pressurized spray compositions available commercially or such products as taught by Lisboa et al in US Patent 5,679,324 or Nakane et al in US Patent 5,122,418 (IDS filed 12/19/2000, Paper No. 2).

Inventions of Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04,

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MPEP § 808.01). In the instant case the different inventions have different modes of operation as they are materially different.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Henry Hadad on January 28, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

ss January 28, 2002 Shahnam Sharareh, Pharmb Patent Examiner, Art Unit 1617